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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,751	12/18/2000	Hiroshi Yanagawa	2000-1713	2790

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WASHINGTON, DC 20006-1021

EXAMINER

PROUTY, REBECCA E

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 06/03/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/737,751

Applicant(s)  
Yanagawa et al.

Examiner  
Rebecca Prouty

Art Unit  
1652



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 3, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 13-22 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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Claims 1-12 have been canceled. Claims 13-22 are still at issue and are present for examination.

Applicants' arguments filed on 3-3-03, paper No. 5, have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

The terminal disclaimer filed on 3-3-03 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 6,228,994 has been reviewed and is accepted. The terminal disclaimer has been recorded.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13-15, and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Vince et al. The rejection is explained in the previous Office Action.

Applicants argue that the labeled protein of the invention is different from the labeled ribosome obtained by Vince because the puromycin analogue of Vince et al. is not linked to the C-

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terminal of the ribosome. It is presumed that by this argument applicants are assuming the ribosome was intended by the examiner to meet the "protein portion" of the labeled protein of Claims 13-15 and 20. This is not persuasive because in fact it is Ac[<sup>14</sup>C]Phe and not the ribosome which is the "protein portion" of the labeled protein produced by Vince et al. The ribosome is a part of the non-radioactive labeling compound which comprises NAP-Lys-PAN covalently linked to a ribosome. The NAP-Lys-PAN (the acceptor portion of the labeling compound) is linked to the C-terminus of the Ac[<sup>14</sup>C]Phe (i.e., the protein portion) and thus Vince et al. do anticipate all of Claims 13-15 and 20. Applicants do not appear to have presented any reason why NAP-Lys-PAN does not constitute a labeling compound within the scope of Claims 21 and 22. Thus the rejection of these claims is maintained as well.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered

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therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nemoto et al. (Reference AQ of applicant's PTO-1449) in view of Promega Technical Bulletin No. 182 (Reference AO of applicant's PTO-1449). The rejection is explained in the previous Office Action.

Applicants appear to believe that the previous rejection suggested replacement of <sup>35</sup>S-labeled methionine with the biotinylated lysine of Nemoto et al. However this is **not** what the rejection stated. As previously explained the rejection stated it would have been obvious to replace the <sup>32</sup>P label in the <sup>32</sup>P-rCpPur with any known non-radioactive label such as a biotin label or a fluorescent label such as fluorescein, i.e., the use of biotinylated-rCpPur or fluorescein-rCpPur instead of <sup>32</sup>P-rCpPur. Contrary to applicants arguments biotinylated-rCpPur or fluorescein-rCpPur would be able to form an intermolecular bond with the C-terminus of a protein during protein synthesis as long as the biotin or fluorescein was bound to the rCpPur at some position besides the free amino group of the puromycin moiety.

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca Prouty, Ph.D. whose telephone number is (703) 308-4000. The examiner can normally be reached on Monday-Friday from 8:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached at (703) 308-3804. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Rebecca Prouty  
Primary Examiner  
Art Unit 1652

